

REMARKS

These points are filed in response to office action dated January 5, 2012. This response addresses rejections of all claims under 35 U.S.C. § 103(a) over Manolis in view of Glassman.

Interview with the Examiner

Applicants thank Examiner Lanier for the courtesies shown during a telephone interview on January 17, 2012 and on February 1, 2012. Applicants discussed the rejections. No agreement as to allowance was reached during the discussion.

Claim Amendments

Claims 53 is amended to clarify that the modules described are software modules. No new matter is added as a result of this change. Support for the modules is available in the Specification as follows. The modules are described as software modules. See Fig. 1. These are described in the Specification¹ at 11:10-27 (16:26-17:12) (describing the modules); 12:11-16 (17:23-26), (stating that these are software programs executed by a computer processor); 12:18-20 (18:1-3) and 13:10-18 (18:21-29) (user account management module 112); 14:28-15:7 (20:9-21), (database interface module 130 and its interaction with security module 120); 17:2-7 (21:9-16) and at 17:12-25 (22:21-23:4) (security module 120). Accordingly adequate structure is believed to exist. This is clarified via an amendment to the independent claim 53, which reads:

one or more non-transitory computer readable storage devices storing processor-executable instructions capable of being executed by the one or more processors, said instructions comprising:

No new matter is added as a result of this clarification. Examiner is respectfully requested to review and enter the amendment.

¹ References without parentheses are to the parent case, Ser. No. 09/478,796. References in parentheses are to the filing Ser. No. 09/634,725.

Support in the Parent Application for restriction on simultaneous use of copyrighted
information objects

At page 2, ¶ 3, the Office Action states:

Applicant argues, "the office action appears to have overlooked that Ser. No. 09/478,796 described copyrighting information objects and using copyrighting to control the use of the information objects ... " In response, the description of the controlled use of copyright-protected information objects is broader than what is being claimed. **For instance, the '796 disclosure is silent with respect to the determining the number of simultaneous users who could access the copyright-protected information object.**

(Emphasis added). Applicant's remarks filed in the December 16, 2011 paper were directed to the office action of October 25, 2011. In the same paper Applicant deleted the final step in the then-existing independent claims (thereby broadening the claims) after discussion with the Examiner via telephone that such deletion would overcome any issue with Meyer as a reference which was filed between the parent application Ser. No. 09/478,796 & the current C-I-P, Ser. No. 09/634,725.

Nevertheless, Applicant submits that there is sufficient disclosure in the parent application to recite the step of controlling a copyrighted information object to restrict the number of simultaneous users. See, e.g., Ser. No. 09/478,796 at 14:12-20, and 14:28-15:7, where the number of requests for information were limited by the payment plan used to release information object to the user. See also, *id.*, at page 18, lines 18-22. Read together, the specification as a whole has adequate disclosure of copyrighting an information object, and controlling the use (for example reselling or retransmitting) of information object via copyright are disclosed, along with a mechanism for the number of times an information object may be used was also disclosed in the parent application. Therefore, this is believed to be sufficient to alert a person of ordinary skill in the art that the number of simultaneous requests for copyrighted

information objects is controlled. The CIP application merely restated the same in different language and clarified some aspects. Examiner is respectfully requested to review and reconsider.

Claim rejections under 35 U.S.C. § 103(a) over Manolis in view of Glassman

Glassman is not a pertinent reference

The Glassman reference is not pertinent because (a) Glassman teaches away from the instant claims under examination, and (b) Glassman's lock server requires a combination of a "specialized lock server and a client program."

A. Glassman teaches away from the claimed combination

A reference must be considered in its entirety, *i.e.*, as a whole, including portions that would lead away from the claimed invention. See *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). In *Ex parte Thusoo* (BPAI No. 2009-012801, App. Ser. No. 10/662,095, Decision date 10-24-2011) a reference was found to "teach away" when it used limiting words which were meant to discourage combination:

Moreover, since this explicit disclosure in Reference [A] uses restrictive words such as "only" and "exactly," we find that an ordinarily skilled artisan would have been discouraged from modifying the RETURNING clause to include the ability to operate on separate rows (*i.e.*, return values from separate rows when a value in each row has been inserted, updated, or deleted).

(Underline added). See also, "Examination Guidelines Update: Developments in the Obviousness Inquiry After *KSR v. Teleflex*" citing as Example 4.6 the case *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 1314 (Fed. Cir. 2009), in which case the Court stated:

Here, Medtronic asserts that achieving a rigid pedicle screw was itself the reason to combine Puno and Anderson. In rebuttal, DePuy argues, and the district court found, that Puno "teaches away" from a rigid screw because Puno warns that rigidity increases the likelihood that the screw will fail within the human body, rendering the device inoperative for its

intended purpose. Ensnarement Order, 526 F. Supp. 2d at 172. The district court thus found that Puno's teachings undermine the very reason Medtronic proffers as to why it would have been obvious to combine Puno and Anderson, viz., the creation of a rigid screw.

DePuy Spine, 1326-27. (Underline added). There is a difference between “teaching” and “teaching away.” Both may describe a method or a possible combination, but in the latter, a statement limiting the use of the method or combination will effectively discourage a person of skill from pursuing the described path. It is the criticism or discouragement or limited applicability of the reference that makes it “teaching away.” See *In re Kahn*, 441 F.3d 977, 990 (Fed. Cir. 2006).

Glassman clearly states that the then-existing lock servers would not work with an open network because an open network has additional requirements such as an unlimited number of potential users. Glassman solved this issue via “license scrip”. The instant claims are directed to providing access to the copyrighted information objects to account-holding users, whereby the server computer is aware of the users who seek access. Glassman is therefore not pertinent.

B. Glassman's “lock server” requires interaction with a “client program”

Glassman states:

In existing systems, the license control is performed by a combination of a specialized lock server and a client program. The lock server validates users' requests for access to the content and maintains the status of active users. The client program interacts with the lock server to acquire a lock and to provide access to the content.

See Glassman, (USP 6,453,305) at Col. 1, line 66-Col. 2, line 4. Glassman is not apposite to invalidate claim 24 because Glassman requires a “client program [that] interacts with the lock server to acquire a lock and to provide access to the content.” Because a reference must be viewed as a whole, Glassman is not pertinent as a reference. Reconsideration is respectfully requested.

Manolis is not a pertinent reference

The office action states that Manolis does not teach or suggest licensing copyrighted information objects. Other than a conclusion that it was possible, the office action did not articulate any reason why any person of ordinary skill, given Manolis would have looked to Glassman. Applicants respectfully request the Examiner to set forth the reasons why one would have looked to Glassman.

What was the scope of the prior art? What technological area was the office looking at to determine the content of the prior art? What particular problem was faced by a person of skill in the art, given Manolis, to look to Glassman, and where is the evidence that someone was motivated to solve the problem? What is the level of the skill of this person² in the art? What qualifications are necessary for the person of ordinary skill to solve the particular problem? And why one would not be dissuaded by Glassman's teaching away from the combination proposed by the Examiner? These questions are to be answered in order to state a *prima facie* case of obviousness. Otherwise, rejection on grounds of obviousness is not correct.

Prima facie case for Graham factors

The office action has not provided a *prima facie* case of obviousness in that it did not set forth the factual foundations. See *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). "Obviousness is a question of law based on underlying factual inquiries. The factual

² See *Graham v. John Deere Co.*, 383 U.S. 1, 16 (1966). These factors are important to make a *prima facie* case under 35 U.S.C. § 103(a) or the Applicant is at a loss in attempting to rebut the *prima facie* case. For example, in *Pfizer, Inc. v. Apotex, Inc.*, 480 F.3d 1348, 1356, 1360 (Fed. Cir. 2007), "The district court first found that a person of ordinary skill in the art would have a bachelor's degree in pharmaceutical science or analytical chemistry, and some experience in drugs and drug preparation." And in *Brown & Williamson Tobacco Corp. v. Philip Morris, Inc.*, 229 F.3d 1120, 1125 (Fed. Cir. 2000), "The district court found, and the parties do not dispute, that a person of ordinary skill in the art of cigarette design in 1985 would have had a bachelor's degree in either engineering, chemistry, physics, or chemical engineering, and would have had at least five years experience in the field of cigarette design."

inquiries enunciated by the Court are as follows: (A) Ascertaining the differences between the claimed invention and the prior art; and (B) Ascertaining the differences between the claimed invention and the prior art; and (C) Resolving the level of ordinary skill in the pertinent art. Objective evidence relevant to the issue of obviousness must be evaluated by Office personnel. *Id.* at 17-18, 148 USPQ at 467.” M.P.E.P. § 2141 (II). Applicant requests the Examiner to set forth these factual findings.

Examiner is requested to make factual findings to support a prima face case of obviousness

The office action states:

Manolis does not disclose that the images can be copyrighted images that are bound by license restrictions. Glassman discloses providing licensed access to copyrighted content for a period of time (Abstract & Col. 1, lines 42-50)....

* * *

It would have been obvious to one of ordinary skill in the art at the time the invention was made for the online print service of Manolis to provide licensed access to copyrighted images in order to provider account users with the ability control access to their copyrighted images at the same time providing concurrent access to the images as suggested by Glassman (Col. 1, lines 55-62 & Col. 2, lines 27-31).

See Office Action of January 5, 2012, at page 13, ¶ 19. MPEP § 2141 III requires a “clear articulation of the reason(s) why the claimed invention would have been obvious”. See also, *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Applicants believe that the office action does not make factual findings sufficient to justify the combination of Manolis with Glassman. Therefore Applicants respectfully request the Examiner to set forth such findings in view of the above arguments.

If Glassman was a person of skill in the art, then is his failure not failure of others?

Assuming, *arguendo*, one of skill in the art, given Manolis, could have looked to Glassman, their failure is an objective piece of evidence that Examiner is respectfully requested to consider. In *Graham v. John Deere Co.*, 383 U.S. 1 (1966), the Court stated:

"secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy."

Id., 383 U.S. at 17-18. Secondary considerations include identified need and failure of others, which is present from Glassman itself. If a person of skill in the art could not have come up with the invention, rejection under 35 U.S.C. § 103(a) is not correct. For example, in *Smith v. Goodyear Dental Vulcanite Co.* 93 U.S. 486 (1876), the Court upheld patent claims directed toward dentures made with vulcanized rubber, stating:

"We cannot resist the conviction that devising and forming such a manufacture by such a process and of such materials was invention. More was needed for it than simply mechanical judgment and good taste. Were it not so, hard rubber would doubtless have been used in the construction of artificial sets of teeth, gums, and plates long before Cummings applied for his patent. To find a material, with a mode of using it, capable of being combined with the teeth in such a manner as to be free from the admitted faults of all other known combinations, had been an object long and earnestly sought. It had been a subject for frequent discussion among dentists and in scientific journals. The properties of vulcanite were well known; but how to make use of them for artificial sets of teeth remained undiscovered, and apparently undiscoverable, until Cummings revealed the mode. But when revealed its value was soon recognized, and no one seems to have doubted that the resulting manufacture was a new and most valuable invention."

Id., at 494-95 (Emphasis added). The Court found that the patentee found something out of the ordinary because every person of skill in the art had the same incentive to invent the

patented invention as the patentee (because the building blocks were known), but every other person of skill failed to do what the patentee did.

Was Glassman a person of ordinary skill in the art?

Assuming, without conceding, that either Manolis or Glassman is a person of ordinary skill in the art³, they are proof that the instant claimed invention was not within the reach of one of such skill. Glassman identified a problem as follows:

For these reasons, existing lock servers are undesirable on an open network.

A lock server providing an N-user license on an open network should also support the following requirements: an unrestricted set of potential users; no single administrative domain covers all users; the users do not need to have a separate user application for each source of content; access to the content can be easily restricted; and the content exists on the server and not with the user.

Accordingly, there is a need for a way to provide restricted access to electronic content that works with a wide variety of possible access schemes. Preferably, the solution will allow enforcement of an N-user license for content located on an open network like the Internet.

Glassman, Col. 2, ll. 15-31. Glassman not only found that existing lock servers were insufficient, but also states that there was an unmet need for restricted access to licensed electronic content. Glassman went on to solve the problem with the “license scrip”, but did not come up with what is claimed herein. As the office action acknowledges, Manolis did not

³ Scholars have noted that evidence of skill in the art is found based on whether an identified need was satisfied or not. See, e.g., 2 DONALD S. CHISUM, CHISUM ON PATENTS § 5.03[4][a], at 5-209 (2005 & Supp.) (“Yet, if an express finding as to the level of ordinary skill in the art is really critical in every case, then surely these factors [of “long-felt but unsolved needs and failure of others in the art”] would be considered as direct and primary evidence as to the level of skill in the pertinent art.”) This is because one cannot postulate a person of ordinary skill to be anything other than based on what they have in fact done. See, e.g., *Automatic Devices Corp. v. Cuno Eng'g Corp.*, 117 F.2d 361, 364 (2d Cir.), *rev'd*, 314 U.S. 84 (1941), where the court stated that “the best test of what persons of routine ingenuity *can do* is what they *have done*.” (italics added). Likewise, in *Western States Mach. Co. v. S.S. Hepworth Co.*, 147 F.2d 345, 347 (2d Cir. 1945), the Court stated, “As we have often repeated, in judging what requires uncommon ingenuity, the best standard is what common ingenuity has failed for long to contrive under the same incentive.”

contemplate delivering copyrighted material. Applicants believe that it is sufficient to state that one of ordinary skill in the art would not have found these claims obvious.

Rejection of Claim 46

The Office Action objected to the language in the claim that refers to “prohibiting” a user from using a copyrighted information object. The objection appears to rest on the ground that the term “prohibiting” is not used in the Specification of the parent case Ser. No. 09/478,796. The Office Action also states that other than simply describing legal consequences of violating the rule against transmitting copyrighted information objects,

“the specification does not disclose any mechanisms to actually prevent the retransmission from occurring. For the purpose of examination, the claim will be treating as forbidding retransmission based on the objects designation as copyright-protected.”

See Office Action at page 4. However, this remark appears to overlook that the Specification not only states that the use of a copyrighted information object beyond an expiration time is controlled, but also provides mechanisms for such control. For example, the Specification of Ser. No. 09/478,796 describes mechanism for controlling the use of information objects at 13:10-12 & at 14:12-20. Thus, one way of enforcing the control over the use of the information objects is by requiring payment and blocking access for nonpayment, and another way was to create a specific key for each type of information object and limit the type of information that can be accessed, the number of times information can be accessed etc. Therefore there is sufficient disclosure in the parent application for the recitation of claim 46. Examiner is respectfully requested to review and reconsider.

Conclusion

The Examiner is requested to set forth a reason one why one of ordinary skill would have, given Manolis, looked to Glassman, or even if one looked to Glassman, what problem

would have been solved, how the problem would have been solved, why that person would have utilized a method rejected in Glassman (as not useful in an open network such as the Internet) to solve the problem that Glassman states cannot be solved that way. Applicants are in the dark and cannot understand the rejection in light of the existing law of obviousness.

Applicants believe that the notice of allowance issued in 2010 was proper and despite numerous iterations the office action did not make a *prima facie* case of obviousness under section 103(a). Therefore Applicants respectfully request the Examiner to set forth the factual findings to make the *prima facie* case in order to permit rebuttal, or alternatively allow the claims. No fee is believed to be due with this paper.

Respectfully submitted,

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